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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/292,444	04/15/1999	CARY LEE BATES	RO998-222	3572

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EXAMINER

SINGH, RACHNA

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 03/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/292,444

Applicant(s)

BATES ET AL.

Examiner

Rachna Singh

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 April 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to communications: application, filed 04/15/99.
2. Claims 1-16 are pending in the case. Claims 1, 10, and 13 are independent claims.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 6-7, 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stork et al., US Patent 5,781,914, 7/1998 and further in view of Kogan et al., US Patent 5,809,317, 9/1998.

In reference to claim 1, Stork discloses a method in which an electronic document can be converted into a hardcopy document while encoding hypertext link information. See column 1, lines 5-10. The document is scanned to identify links. See column 9, lines 9-10. Stork teaches that the encoded information includes location information such as the line number in order to identify the area of the hyperlink. See column 5, lines 1-30. Stork does not disclose a method for checking printable objects to identify hypertext anchor tags; however, Kogan teaches the creation and maintenance of hypertext links among documents through the use of anchors. See abstract. Kogan teaches using database management technology to relate anchors to links and links to anchors. See

column 5, lines 20-30. See also figures 6-8. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Stork's method of identifying hypertext links in a hardcopy document (capable of being printout) with Kogan's method of checking objects for hypertext anchor tags with a related link since it enables the identification of hypertext links within a document as well as its location. Both Stork and Kogan are of analogous art.

In reference to claim 2 and 6, both Stork and Kogan disclose that a hypertext link can be linked to information within the document or an external document. See Stork, column 4, lines 39-41 and Kogan, column 1, lines 46-50.

In reference to claim 3, Stork discloses identifying the location of the hypertext link by line number. See column 5, lines 5-25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print out a hardcopy identifying the page number for an internal link since it was well known in the art to identify the location of the related hyperlink region with a line number.

In reference to claim 7, Stork discloses encoding information consisting of actual path information (URL). See column 5, lines 25-30. It would have been obvious to one of ordinary skill in the art at the time the invention was made to display the URL for an external link since it was common to identify the path in a hyperlink.

In reference to claim 10, Stork discloses identifying hypertext links in document printouts in which the data is stored in memory. See figure 3. Stork also discloses an option to print the hardcopy document. See columns 1-2.

Stork does not disclose a predefined indication of each hypertext link; however Kogan does. Kogan teaches using database management technology to relate anchors to links and links to anchors. The rest of claim 10 is rejected under the same rationale used to reject claim 1 above.

In reference to claim 11, Stork discloses encoding path information in the hardcopy. See column 5, lines 20-30. It would have been obvious to one of ordinary skill in the art to print the URL since the path name was already encoded in the hardcopy document.

In reference to claim 12, Stork discloses identifying the location of the hypertext link by line number. See column 5, lines 5-25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print out a hardcopy identifying the page number for an internal link since it was well known in the art to identify the location of the related hyperlink region with a line number.

In reference to claim 13, Kogan discloses a system consisting of a storage devices such as magnetic disk or optical disk. See column 6, lines 15-49. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a computer program product consisting of recording mediums to carry out the means for checking printable objects. The rest of claim 13 is rejected under the same rationale used to reject claim 1 above.

Claim 14 is rejected under the same rationale used to reject claim 3 above.

Claim 15 is rejected under the same rationale used to reject claim 7 above.

Claim 16 is rejected under the same rationale used to reject claim 3 above.

5. Claims 4, 5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stork et al., US Patent 5,781,914, 7/1998 and Kogan et al., US Patent 5,809,317, 9/1998 as applied to claim 1 above and further in view of Microsoft Word Tutorial, "Microsoft Word Basic Features".  
<http://baycongroup.com/wlesson0.htm>, Microsoft Word 1997.

In reference to claims 4, 5, and 8, it was notoriously well-known in the art at the time the invention was made to modify text to be displayed in various formats such as superscript form or bold form. See Microsoft Word Tutorial, pages 3-4. It would have been obvious to one of ordinary skill in the art of document display to modify the printable text of Stork to be represented in bold or superscript form.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stork et al., US Patent 5,781,914, 7/1998 and Kogan et al., US Patent 5,809,317, 9/1998 as applied to claim 1 above and further in view of Advanced Microsoft Word, "Footnotes and Endnotes"  
<http://www.utexas.edu/cc/training/handouts/wordadv/>

In reference to claim 9, it was notoriously well-known in the art at the time the invention was made to display text in footnote form. See Advanced Microsoft Word, pages 3-7. It would have been obvious to one of ordinary skill in the art of

document display to modify the printable text of Stork to be represented in footnote form.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,178,431	Douglas	1/2001(filed 10/1994)
US Patent 5,987,482	Bates	11/1999(filed 9/1997)
US Patent 5,694,594	Chang	12/1997
US Patent 6,332,148	Paine et al.	12/2001 (filed 5/1997)
US Patent 6,122,647	Horowitz et al.	9/2000(filed 5/1998)
US Patent 5,724,595	Gentner	3/1998

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachna Singh at 703.305.1952. The examiner can normally be reached on Monday-Friday from 8:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at 703.308.5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703.305.3900.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**After-Final                      703.746.7238**

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**Official 703.746.7239**  
**Non-Official/Draft 703.746.7240**

Hand-Delivered responses should be brought to Crystal park II, 2121 Crystal Drive, Arlington VA., Sixth Floor (Receptionist).

Rachna Singh  
March 22, 2002

*Heather K. Herndon*  
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